

that Claim 15 be considered along with Claims 1, 10 and 13, 14, 16 and 17. Favorable action is solicited.

The Examiner has repeated the rejection of Claims 1, 10 and 13, 14, 16 and 17 under 35 U.S.C. §112, ¶1, as failing to comply with the enablement requirement. In further support of his position, the Examiner refers to the teaching of *Sbragia et al.* (US 5,886,221) and the teaching of *Thoms et al.* (US 5,691,383) for their showing that ants are affected differently by the same benzoylphenyurea compound. More specifically, the Examiner pointed out *Sbragia et al.* show that a fire ant is effectively treated by hexaflumuron whereas Pharaoh ants are not. It is respectfully submitted that the respective data of *Sbragia et al.* only show that an application of hexaflumuron in an amount of 0.1% did not achieve a 50% or 90% brood reduction within 10 weeks. However, as corroborated by the corresponding data pertaining to the effect of hexaflumuron on the fire ants, a higher application concentration of 0.25% can be expected to provide for the desired control. The mere fact that different compounds require different application rates is, in itself not deemed to suggest or imply that the application of hexafumeturon has no effect on the Pharaoh ant. Essentially the same applies to the Examiner's remarks concerning *Sbragia et al.*'s investigations concerning Daphnia. *Sbragia et al.* themselves merely state that compounds 2 and 3 were "much less active" than compound 1 and hexaflumuron. Essentially the same is applicable where the data disclosed by *Thoms et al.* are concerned. Neither the data of *Sbragia et al.* nor the data of *Thoms et al.* suggest or imply that the investigated compounds are unsuited for the desired control. The data merely show what is well known in the art: if either different compounds within predetermined structural parameters are applied to one particular ant, or the same compound is applied to different ants, it might be required to adapt the application rate in order to achieve the same degree of control.

For essentially the same reasons the Examiner's position is not deemed to be well taken that applicants' data show that only a few compounds were 50% lethal to the Coptotermes strain. The data in applicants' Table 6 show that 1 ml of a 500 ppm solution of the investigated compounds results in at least 50% mortality<sup>1)</sup>. The fact that not all of the investigated compounds exhibited 100% mortality

1) A rating "D" means 50-79% mortality, a rating "C" means 80-89% mortality, a rating "B" means 90-99% mortality and a rating "A" means 100% mortality; cf. page 28, indicated lines 23 to 27, of the application.

at the investigated application rate, does not suggest or imply that the respective degree of action cannot be achieved by increasing the application rate of the compounds accordingly. The adaption of the application rate of a compound within predetermined structural parameters to the specific desired result is not deemed to be more than a routine effort of optimization.

The Examiner asserts that the delivery form is of criticality, referring to col. 8, indicated lines 1 to 3. It is respectfully submitted that neither the teaching of *Sbragia et al.* nor the teaching of *Thoms et al.* support that the application form and its criticality are outside of the general technical background knowledge of one of ordinary skill in the art. The Examiner's attention is, in this regard, drawn in particular to the explanations provides by *Sbragia et al.* in col. 10, indicated lines 5 to 49, of **US 5,886,221**.

The Examiner's position that applicants' claims lack support by an enabling disclosure is, in light of the foregoing and the arguments previously presented by applicants, not deemed to be well taken. Favorable reconsideration of the Examiner's position and withdrawal of the rejection of Claims 1, 10 and 13, 14, 16 and 17 under Section 112, ¶1, is, therefore, respectfully solicited.

The Examiner has repeated the rejection of Claims 1, 10 and 13, 14, 16 and 17 under 35 U.S.C. §102(b) as being anticipated by, or under 35 U.S.C. §103(a) as being rendered obvious by, the teaching of *Toki et al.* (EP 500 111) or the teaching of *Harrison et al.* (WO 92/06076). In this context, the Examiner argues that it is within the skill of a person of ordinary skill in the pertinent field to perform the "minimal experimentation" which is needed to arrive at applicants' method.

However, for anticipation under Section 102(b) the prior art has to show exactly what is claimed in as complete detail as is contained in the claims<sup>2)</sup>. Neither one of the teachings referenced by the Examiner meets these standards developed by the Court. Withdrawal of the Examiner's rejection under the provisions of Section 102(b) is, therefore, respectfully solicited.

With regard to the rejection under Section 103(a) it is respectfully urged that the manner in which an invention is made has no impact on the patentability of the claimed subject matter<sup>3)</sup>. The fact

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2) Cf. ftn. (8) to (10), pages 3 and 4 of applicants' reply dated March 02, 2004.

3) Cf. 35 U.S.C. §103(a), last sentence.

that a person of ordinary skill in the art could have arrived at applicants' method by conducting routine experiments in which each of the compounds which falls within the generic realm of the compounds addressed by *Toki et al.* or by *Harrison et al.* is evaluated for its effectiveness against each of the pest species falling within the generic realm of pests addressed by *Toki et al.* or by *Harrison et al.* is, therefore, insufficient to conclude that applicants' method is rendered *prima facie* obvious by either one of the references.

Obviousness within the meaning of Section 103(a) requires more than the mere possibility to make a selection from the generic disclosure of a reference which selection mirrors the combination of requirements set forth in an applicant's claim. For obviousness under Section 103(a), the reference also has to provide some teaching or suggestion which would motivate a person of ordinary skill in the art to make the particular selection which results in the claimed combination<sup>4)</sup>. Neither the teaching of *Toki et al.* nor the teaching of *Harrison et al.* provide a motivation to specifically select the compounds which fall within the realm of applicants' formula (I-1) and to employ these specific compounds in the control of the particular ants defined in applicants' claims<sup>5)</sup>. Where -as here- the motivating teaching or suggestion is not found in the reference, any possible selection and combination within the generic disclosure is equally likely and a person of ordinary skill needs to test each compound for its effectiveness against each of the pests. Under those circumstances, the reference issues no more than an invitation to make and try out each of the possible selections and combinations. "Obvious to try" is, however, not a proper basis for finding that a claimed invention is unpatentable under Section 103(a)<sup>6)</sup>. Also, under those circumstances, a focus on the particular selection which results in the claimed combination would have to be regarded as being based on hindsight<sup>7)</sup>.

4) In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991). See also In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (CAFC 1994); In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (CAFC 1992).

5) Note in particular In re Jones, 958 F.3d 347, 21 USPQ2d 1614 (CAFC 1992), and In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (CAFC 1994), which point out that a genus does not even render all species that happen to fall within the genus obvious.

6) Cf. Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (CAFC 1989) where the Court held that an invention was merely "obvious to try" if the prior art gives either no indication of which parameters are critical or no direction as to which of the many possible choices is likely to be successful.

7) Cf. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (CAFC 1988).

The Examiner's position that applicants' claims are rendered obvious by the teaching of *Toki et al.* or the teaching of *Harrison et al.* is, in light of the foregoing and the arguments previously presented by applicants, not deemed to be well taken. Favorable reconsideration of the Examiner's position and withdrawal of the rejection of Claims 1, 10 and 13, 14, 16 and 17 under Section 103(a), is, therefore, respectfully solicited.

The Examiner has newly rejected Claims 1, 10 and 13, 14, 16 and 17 under 35 U.S.C. §102(b) as being anticipated by the teaching of *Treacy et al.* (US 6,342,518). In this context, the Examiner asserts that *Treacy et al.* show that a compound falling within the realm of applicants' formula (I-1) was used to control cockroaches, ants, termites or the like.

Applicants respectfully disagree with the Examiner's summary of the teaching of *Treacy et al.* *Treacy et al.*'s teaching provides for an insecticidal composition<sup>8)</sup> which comprises synergistically effective amounts of

- (a) a neuronal sodium channel antagonist which *inter alia* encompasses compounds as represented by applicants' formula (I-1), and
- (b) an arylpyrrole,

and *Treacy et al.* teach that the composition is effective against a wide variety of lepidopteran and coleopteran insects such as cotton bollworm, tobacco budworm, potato beetle and corn rootworm and the like<sup>9)</sup>. Additionally, *Treacy et al.* merely state that<sup>10)</sup>

... the composition ... may be useful in the prevention and control of public health pests such as houseflies, mosquitos, cockroaches, ants, termites or the like.

On the one hand, *Treacy et al.* merely mention the possibility that the composition itself "may be" useful to control cockroaches, ants, termites or the like. The respective statements clearly fall short from a showing that the composition is suitable for the requisite purpose. On the other hand, the fact that *Treacy et al.* refer in this context to the composition rather than one of its constituents clearly cannot be interpreted as a showing that the application of any neuronal sodium channel antagonist in suitable amounts will result in a control of control cockroaches, ants, termites or the like. The

8) Cf. col. 1, indicated lines 61 to 67, of US 6,342,518.

9) Cf. col. 7, indicated lines 26 to 31, of US 6,342,518.

10) Cf. col. 7, indicated lines 32 to 35, of US 6,342,518, emphasis added.

teaching of *Treacy et al.* clearly fails to show exactly what is claimed in as complete detail as is contained in the claim<sup>11)</sup> including the "part-to-part relationships" which are set forth in applicants' claims and which give those claims their meaning<sup>12)</sup>. As such, the teaching of *Treacy et al.* cannot be regarded as a disclosure which anticipates the subject matter of applicants' claims within the meaning of Section 102(b). Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is respectfully solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. Please charge the requisite fee in the amount of \$980.00 to Deposit Account No. 11.0345.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,  
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11) Cf. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (CAFC 1985); In re Marshall 577 F.2d 301, 198 USPQ 344 (CCPA 1978); In re Kalm 378 F.2d 959, 154 USPQ 10 (CCPA 1967); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989); Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (CAFC 1984).

12) Cf. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (CAFC 1984).